

Application No. 09/538,493
Reply to Office Action of Aug. 26, 2003

REMARKS

Applicant thanks the Examiner for the courtesy of conducting an interview on July 22, 2003, to discuss possible groupings of the claims.

In the Office Action following the interview on August 26, 2003, the Office asserts that the application includes 11 distinct inventions. Applicant appreciates that there appear to be distinct groupings of claims. However, Applicant believes that it would be efficient to proceed with examination of the claims in groups 3, 5, 6, and 10, excluding claims 23, 28-30, 70 and 78. In sum, Applicant has provisionally elected group 6, but respectfully traverses the current restriction requirement for the reasons described below.

Many of the claims pending in the application are copied from or are substantially similar to claims 1-57 from U.S. Patent USP 5,889,868. As such, there are a number of potential interference issues that need to be resolved in this application. By subdividing the claims into too many groups, the interference issues will be spread over many separate divisional applications, and may ultimately require the board to defer and consolidate the interference issues until after all of the divisional applications are addressed. Thus, from the perspective of handling the interference issues efficiently, the Office should look to examine at least groups 3, 5, 6 and 10 (as modified below) so that issues related to the patentability and interference are addressed together.

Moreover, there is a presumption that the Office found these claims to be sufficiently related to examine them in one application that issued as the '868 patent. Thus, the office should agree to Applicant's request that at least groups 3, 5, 6 and 10 be examined together in this application.

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Applicant believes that the claims in groups 3, 5, 6 and 10 should be examined together, with the exception that claims 23, 28-30, 70 and 78 be removed from this collection of claims. Each of the independent claims in these groups, with the exception of claims 23, 28-30, 70 and 78, relate to digital watermark encoding and related technology for preparing for digital watermark encoding. Claims 23, 28-30, 70 are an exception because they correspond to independent claims reciting digital watermark decoding operations, such as analyzing a composite signal for the presence of a digital watermark.

Because of the relationship of the subject matter in these claims, and the efficiency of addressing related interference and patentability issues together, Applicant requests the Office to examine at least claims 6, 7, 9-14, 16, 20-22, 46-68, 71-72, 74, 85-86, and 94-133.

Though the Office contends that there are 11 distinct inventions, this contention is insufficient, by itself, to require Applicants to prosecute 11 different applications for the pending claims. MPEP Section 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In addition, with the availability of computer search tools and other on-line keyword-based information services, many if not all, of the separate classes and subclasses can be searched simultaneously. This too reduces the burden of examining all the claims in a single application.

Applicant submits that in the instant case that an examination and search can be made without serious burden at least to claims 6, 7, 9-14, 16, 20-22, 46-68, 71-72, 74, 85-86, and 94-133. Claims 1-57 can be examined together as evidenced by the past examination of U.S.

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patent No. 5,889,868. That is, claims 1-57 correspond exactly or substantially to the claims recited in the '868 patent and the application that matured into the '868 patent was not subjected to a restriction requirement. Hence, Applicant submits that this application should be afforded similar treatment.

Respectfully submitted,

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